

Application No. 09/993,780
Amendment "F" dated June 30, 2005
Reply to Office Action mailed May 9, 2005

REMARKS

Initially, Applicants would like to thank the Examiner for granting the latest in person interview, held on June 15. The amendments made by this paper are consistent with the proposals discussed during the interview.

The Non-final Office Action, mailed May 9, 2005, considered and rejected claims 3-8, 13-15, 27-30 and 37-69 under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US Patent No. 6,388,714) in view of Woo (US Patent No. 5,485,219).¹

By this paper, claims 37, 44, 50, 58, 67 have been amended² and new claims 70-75 have been added³, such that claims 3-8, 13-15, 27-30 and 37-75 now remain pending, of which claims 37, 44, 50 and 58 are the only independent claims at issue.

As reiterated during the interview, claims 37 and 58 are directed to a method and corresponding computer program product for enabling a server to control the recording of selected television programming. Claims 44 and 50 are directed to a similar method and corresponding computer program product, only recited from the perspective of the client interactive television system.

The recited method, in each of the claims, includes various acts in which a request from a client for a programming homepage from which a client can request a programming schedule. In response to this request and the selection of a television signal provider from the homepage, the server provides the programming schedule to the client system. Thereafter, a new request from the client, based on a selection from the program schedule that is now displayed at the client, indicates a program to record. The server responds to this request by downloading recording instructions to the client system so that the client system is set up to record the selected program.

As discussed during the interview, the cited art fails, alone and in combination to anticipate or make obvious such a method. In particular, among other things, the cited art fails to disclose or suggest a method wherein a server receives a request from a computing system to access a programming homepage, wherein in response to the request to access the programming

¹ Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

² Support for the claim amendments is drawn from various passages of the specification, including, but not limited to the disclosure found in paragraphs [0131]-[0134].

³ Support for the new claims is drawn from various passages of the specification, including, but not limited to the disclosure found in paragraphs [0024], [0135]-[0136] and [0144].

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homepage, the server provides the computing system access to a programming homepage that identifies a plurality of television signal providers; and wherein the server receives a selection of an appropriate one of the plurality of television signal providers from the homepage; and wherein in response to the computing system selecting the appropriate television signal provider, and upon receiving a request from the computing system for a corresponding program schedule, the server provides the programming schedule to the computing system, as claimed.

For example, in Woo, it is clear that the control station "periodically transmits a TV program schedule table that is stored in the processor," and from which the user selects a program for controlled recording. Col. 2, ll. 9-21. A user does not access the program schedule from a website, as claimed. Furthermore, in Schein, although EPG data is shown, which can be accessed from a remote website, (abstract), Schein fails to disclose or suggest a programming homepage that identifies a plurality of television signal providers from which the user selects one of the providers to access the program schedule and from which a program can be selected for recording, as claimed.

Furthermore, with specific regard to Schein Figure 14, a record option for selecting a program to be recorded is illustrated. However, there is nothing to suggest that this option would initiate or correspond to the downloading of recording instructions from a remote server, as claimed. For example, this could simply initiate recording from a device at the client system. However, there is no disclosure in Schein that appears to adequately describe this feature. Accordingly, in this regard, Schein should not be used as purportedly teaching the selection of a program for recording from a remote server, when Schein is clearly silent on this matter.

At some point during the interview, the Examiner appeared to suggest that the possibility of something happening (see above), based on the disclosure in a reference, can be sufficient to make it obvious. Applicant respectfully disagrees for at least the following reasons.

Initially, Applicant reminds the Examiner that in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all claim limitations." MPEP § 2143. Furthermore, "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS. A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all

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aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references."⁴

Furthermore, Applicants also point out that with regard to any art that might be combined by the Examiner in any future rejection of this case, that the motivation for making such a combination must come from the references themselves, not the Applicant's own application⁵, otherwise such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure."⁶

In view of these guidelines and the fact that the cited combination of art fails to disclose all of the recited limitations, Applicants respectfully submit that the pending claims are now in condition for prompt allowance.

Although the forgoing remarks have focused primarily on the independent claims, it will be appreciated that, for at least the foregoing reasons, all of the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually⁷. Nevertheless, some of the dependent claims will be pointed out at this time to even further clarify and distinguish the claimed invention from the art of record.

Claim 37, for example, recites that the recording instructions are embedded in and received with the television programs. (paragraph 144) This is neither taught nor suggested by the art of record, particularly when considering that embedding the recording instructions can include inserting the recording instructions in a special television channel or inserting the recording instructions as a binary ASCII-format character string that is assigned specific control functions (claims 74-75).

The cited art also fails to disclose that the programming information is made available to the user based on a determination of at least one of a caller ID, area code and phone number of

⁴ MPEP 2143.01, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

⁵ MPEP 2143. *In re Vaack*, 947 F.2d 488 (Fed. Cir. 1991).

⁶ *Id.* (*emphasis added*)

⁷ However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should the need arise, including any official notice.

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the user (claim 69), or that appropriate programming information is based on determining a locality of a user's modem (claim 70), particularly wherein the locality of the user's modem is determined according to a caller ID (claim 71) or a phone number (claim 72).

Finally, the cited art also clearly fails to disclose or suggest a method as claimed, wherein subsequent to downloading recording instructions, the server transmits data comprising an end-of VCR control information to the computing system (claim 73). Support for this and the other new claim elements is found throughout the specification, including paragraphs [0024], [0135]-[0136] and [0144].

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 30 day of June, 2005.

Respectfully submitted,



RICK D. NYDEGGER
Registration No. 28,651
JENS C. JENKINS
Registration No. 44,803
Attorneys for Applicant
Customer No. 047973

RDN:JCJ:ac
PPA0000000326V001